

REMARKS

Claims 1-19 are pending in the present application.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of 02/01/2005, the following actions were taken:

- (1) The Examiner objected to claims 2-19 due to specific informalities.
- (2) The Examiner objected to claim 5 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim.
- (3) The Examiner rejected claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,750,482 (hereinafter "Cummings").

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Claim objections

The Examiner has objected to claims 2-19 due to specific informalities in claim 2. As per the Examiner's suggestion, claim 2 has been amended to correct these informalities and the Applicant requests that the objection be withdrawn. As claims 3-19 were objected to due to their dependence from claim 2, the Applicant also requests that these objections be withdrawn.

The Examiner has objected to claim 5 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. As such, claim 5 has been canceled by the present amendment.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over Cummings. Note that claims 1 and 2 have been amended in order to clarify specific patentable aspects of the present invention. The Applicant respectfully submits that these claims are patentable over the cited reference for the

reasons set forth below, and that the rejection should be withdrawn. The following discussion is currently focused on the reference lacking each and every element of the claims of the present application. Therefore, the following discussion of applicable case law is considered an important background for the Examiner to keep in mind during this discussion.

In order to maintain a *prima facie* case of obviousness by combining teachings in a reference or by combining references, the prior art must provide some reason or motivation to make the claimed compositions. *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990). As aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992):

"Before the PTO may combine the disclosure of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art... Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the...art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed (invention)."

The same reasoning applies to combining teachings from a single reference. An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich et al.*, 220 U.S.P.Q. 504, 509-511 (CCPA 1979). There the court states that the question of a § 103 case is what the reference would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

"Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or any suggestion leading to their combination in the manner claimed by applicants." (underlining added)

It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning lead the court, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

"...it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made."
(underlining added)

In re Sernaker, 217 U.S.P.Q. 1, 5-6, (Fed. Cir. 1983) states a test to determine whether a rejection of an invention based on a combination of prior art elements is appropriate as follows:

"The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings...The board never showed how the teaching of the prior art could be combined to make the invention." (underlining added)

Moreover, in *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, (Fed. Cir. 1988), the court states that both the suggestion and the expectation of success must be founded in the prior art, not in the applicants disclosure. The Federal Circuit stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (Fed. Cir. 1979):

One of the more difficult aspects of resolving questions of non-obviousness is the necessity "to guard against slipping into use of hindsight (citing *Graham v. Deere*). Many inventions may seem obvious to everyone after they have been made...(citation of §103)...Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

With the above background in mind, Applicant contends that the Examiner has failed to meet its burden of making a *prima facie* case of obviousness. The Examiner has failed to show that the cited reference provides sufficient teachings or motivation to combine in order to arrive at Applicant's invention. Further, Applicant contends that the combination of reference teachings is based on hindsight. Therefore, without

knowledge of the disclosure of the present invention, one of ordinary skill in the art would not be able to make the combinations proposed to arrive at the claimed invention.

The Cummings reference

The Examiner has rejected claims 1-19 as being unpatentable over Cummings. Cummings teaches a glass cleaner composition comprising ethylene glycol monohexyl ether as a high boiling point organic solvent, a surfactant, and water. (See column 3, lines 45-47). The composition can also include a pH modifying agent, a fluorocarbon surfactant, and an organic cosolvent. (See column 3, lines 48-50). Cummings further teaches that the ethylene glycol monohexyl ether component can be regarded as the primary solvent of the composition. (See column 3, lines 50-51). As such, Cummings teaches that ethylene glycol monohexyl ether is a critical component that “enhances the performance of the composition greatly,” and that the “performance is excellently suitable for cleaning glass surfaces.” (See column 3, lines 52-58). Thus one skilled in the art would naturally learn from Cummings that ethylene glycol monohexyl ether is an essential component of this glass cleaning composition.

Amended claim 1 of the present application discloses an aqueous cleaning composition for hard surfaces comprising an inorganic acid, a surfactant, and a lower alcohol solvent. The lower alcohol solvent is selected from the group consisting of methanol, ethanol, propanol, isopropanol, butanol, t-butanol, pentanol, and combinations thereof. More complicated polyols, such as ethylene glycol monohexyl ether are not included nor considered to be lower alcohol solvents.

The Examiner has stated that it would have been obvious for one skilled in the art to have formulated the composition of claim 1 of the present invention based on the teachings of Cummings, and furthermore that one skilled in the art would have had a reasonable expectation of success. The Applicant respectfully disagrees with this assertion. Cummings does not teach or suggest a cleaning composition lacking ethylene glycol monohexyl ether as presently claimed, and as such, the Examiner has not shown that it would have been obvious to one skilled in the art to have formulated the presently claimed composition. Also, one skilled in the art would not have had a reasonable expectation of success in formulating a cleaning composition as in

Cummings but lacking the "primary solvent." As such, the Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in this rejection.

Therefore, the Applicant respectfully requests that the rejection of claim 1 be withdrawn. Additionally, because claims 2-19 depend from claim 1 and are believed to be narrower in scope, they will not be discussed herein, and are considered to be in condition for allowance.

In view of the foregoing, Applicants believe that claims 1-19 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone the undersigned at (801) 566-6633 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 20-0100.

Dated this 25th day of April, 2005.

Respectfully submitted,



M. Wayne Western
Attorney for Applicant
Registration No. 22,788

Of:

THORPE NORTH & WESTERN, LLP
8180 South 700 East, Suite 200
Sandy, Utah 84070
(801) 566-6633